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EXAMINER	
RIVELL, J	
ART UNIT	PAPER NUMBER
3407	7

34M1/0309
TOWNSEND AND TOWNSEND KHOURIE AND CREW
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DATE MAILED: 03/09/94

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☑ Responsive to communication filed on 12/23/93 (7/15/93) ☑ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.
3. ☑ Notice of Art Cited by Applicant, PTO-1449. (Paper No. 4)
4. ☐ Notice of Informal Patent Application, PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____.

Part II SUMMARY OF ACTION

1. ☑ Claims 10-30 are pending in the application.
   Of the above, claims _____ are withdrawn from consideration.
2. ☑ Claims 1-9 and 21 have been cancelled.
3. ☑ Claims 29 (15) are allowed.
4. ☑ Claims 10-20, 22-25, 28 and 30 are rejected.
5. ☑ Claims 26-27 are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____. has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application apppears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

PTOL-326 (Rev. 2/93)

Applicant's arguments with respect to claims 10-23 have been considered but are deemed to be moot in view of the new grounds of rejection.

Claim 21 has been cancelled. New claims 24-30 have been added. Thus claims 10-20 and 22-30 are pending.

Claims 10, 11, 12, 13, 14, 15, 16, 18, 19, 20, 22, 23, 24, 25, 28 and 30 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 or 6, 1 or 6, 1 or 6, 2 or 7, 2 or 7, 2 or 7, 2 or 7, 2 or 7, 2 or 7, 9, 10, 2 or 7, 2 or 7, 2 or 7, and 10, respectively, of U.S. Patent No. 5,226, 441. Although the conflicting claims are not identical, they are not patentably distinct from each other because the respective claims of the patent contain all the elements of the respective claims of the application. Such broader instant application claims are said to "dominate" the more narrow patent claims which contain additional features. Thus, when U.S. Patent 5,226, 441 expires one making the invention set forth in the respective claims of the expired patent would be infringing the respective claims of the instant application. This constitutes an unlawful extension of monopoly as set forth in the law. **In re Braithwaite**, 154 USPQ 38,40.

Claim 17 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over

claim 2 or 7 of U.S. Patent No. 5,226, 441, in the manner set forth above, in view of common knowledge in the art. As set forth above the patented claims contain all the claimed features of the claims of the instant application. In this instance the claimed device lacks having a "gasket" to fluidly seal the elements together in "a substantially leak free manner". However it is widely known and notoriously old in the art of fluid handling to employ seals or "gaskets" between separable elements for the purpose of fluidly sealing the elements together. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to employ in the device of the claim a "gasket" for the purpose of fluidly sealing separable elements together as recognized by common knowledge in the art.

Claims 26-27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 29 is allowable over the prior art of record.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

Should applicant proceed by filing a terminal disclaimer applicant is reminded of the new format for terminal disclaimers (see M.P.E.P 1490, Rev., 14 November 1992) and 37 CFR §3.71 and §3.73 for procedures for assignees in submitting terminal disclaimers. Particular attention is directed to 37 CFR §3.73(b) wherein assignees must specify (e.g.reel and frame number) where evidence of ownership is recorded as well as a statement specifying that the evidence has been reviewed and certified.

Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL.** See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Rivell whose telephone number is (703) 308-2599.

j.r.
March 8, 1994

John Rivell
JOHN RIVELL
PRIMARY EXAMINER
ART UNIT 347